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TR 11/30/02 002**OFFICIAL**  
Expedited Examining Procedure  
Group 1734PATENT  
Docket No. 55679US002  
(formerly 55679USA2A.002)**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s):	Conrad V. ANDERSON et al.)	Group Art Unit:	1734
	)		
Serial No.:	09/626,621	Examiner:	Sue Purvis
Confirmation No.:	2487		
	)		
Filed:	27 July 2000		
	)		
For:	GRAPHIC IMAGE FILM REGISTRATION SYSTEMS AND METHODS		

**RESPONSE UNDER 37 CFR §1.116**Assistant Commissioner for Patents  
Attn: Box AF  
Washington D.C. 20231

Dear Sir:

The Final Office Action mailed 29 August 2002 has been received and reviewed. No claims were amended. Claims 1-33 are pending. Reconsideration and withdrawal of the rejections are respectfully requested.

**Finality of Office Action**

A number of new documents were introduced and discussed relative to the rejections of claims 7, 8, 24, 25, and 27-29 (i.e., Hensley et al., U.S. Pat. No. 6,354,984; Shannon, U.S. Pat. No. 4,806,184; Mitchell, U.S. Pat. No. 4,490,198; Lerner et al., U.S. Pat. No. 4,412,876; and Fritz, U.S. Pat. No. 1,498,618).

Applicants respectfully submit that if the Examiner is relying on these new documents in rejecting claims 7, 8, 24, and 25, then the present Final Office Action is premature as the use of the new document introduces new grounds for the rejection of claims 7, 8, 24, and 25 that were

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neither necessitated by an amendment (no claims have been amended), nor based on information submitted in an information disclosure statement by the Applicants under 37 C.F.R. § 1.97(c). *See, e.g.* MPEP § 706.07(c). In fact, the Examiner introduced all of the cited documents, except for Shannon, in the Final Office Action.

As a result, Applicants have not addressed the statements relating to these documents and do expressly reserve the right to traverse those assertions if the rejections are properly presented in a non-final Office Action.

**The 35 U.S.C. 103 Rejection**

Claims 1-33 were rejected under 35 U.S.C. 103 as being unpatentable over asserted admitted prior art in Applicants' own specification in view of U.S. Patent No. 5,252,166 to Krawczyk (hereinafter "Krawczyk") and U.S. Patent No. 4,795,513 to Jensen, Jr. (hereinafter "Jensen"). Applicants respectfully traverse the rejection of claims 1-33.

**Claims 1, 23, and 26**

Applicants respectfully traverse the rejection of independent claims 1, 23, and 26 because the cited documents fail to support a proper *prima facie* case of obviousness as follows.

The Office Action relies upon the asserted admitted prior art in view of Krawczyk and Jensen in rejecting claims 1, 23, and 26. The Office Action asserts that all the elements necessary to arrive at a *prima facie* case of obviousness against claims 1, 23, and 26 are present in the combination of the asserted admitted prior art, Krawczyk, and Jensen.

The Office Action, however, fails to identify a proper suggestion or a motivation as to why one skilled in the art would have chosen to modify the asserted admitted prior art in view of both Krawczyk and Jensen that is supported by the cited references as discussed in Applicants' previous response (dated March 21, 2002).

Briefly, Applicants noted that the cited documents failed to support the asserted suggestion or motivation to modify or combine the reference teachings because the proposed

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combination would change the principle operation of the prior art invention being modified. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious (M.P.E.P. 2143.01). Applicants were not, as asserted, attacking the references individually. Rather, Applicants pointed out that one skilled in the art would not have been motivated to look to the asserted combination of the asserted admitted prior art, Krawczyk and Jensen, as the combination of these documents would change the principle operation of the invention being modified.

In the absence of a properly supported suggestion or motivation to combine all three reference teachings, the only way of arriving at the claimed subject matter is by picking and choosing individual elements from Krawczyk and Jensen based on Applicants' disclosure. Nothing in the cited reference teachings would direct or motivate one skilled in the art to combine these three reference teachings as asserted in the absence of Applicants' own disclosure.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of this rejection as applied to claims 1-33. The rejections and/or assertions regarding specific claims or groups of claims are also addressed in more detail below.

not claimed  
With respect to claim 2, the rejection is premised on the manual tensioning of the asserted admitted prior art, as modified by the teachings of Jensen. The Office Action fails, however, to provide any reasoning as to why or how one of skill in the art would make the leap from a manual, panel-by-panel installation technique in which tension is sporadically applied in a variety of directions (e.g., across the width and length of each panel) to a method in which tension is applied only along the length of the film. In the absence of any identified suggestion or motivation to make that modification, it must be assumed that impermissible hindsight forms the basis for the rejection of claim 2. As such, a proper *prima facie* case of obviousness for claim 2 has not been established.

With respect to claims 6-8, Applicants note that none of the cited references teach removal of registration marks from a film. Any assertion that Krawczyk teaches removal of

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guidelines from a film is not supported by the reference itself. In that regard, Applicants note that the section cited in support of the rejection of claim 6 (i.e., Col. 16, lines 43-47) teaches removing marks from the tiles, not the film as recited in the claims.

With respect to claims 7, 8, 24, & 25, Applicants note that no reference is cited as teaching removal of a portion of a second film. Paragraph 10 of the Office Action (page 6) contains some discussion regarding claims 7 & 24, but Applicants note that it does not address removal of only a portion of a film.

With respect to claims 8 & 25, Applicants note that no reference is cited as teaching removal of a portion of the second film before the second film is applied to the substrate. Nor is any reasoning provided as to why one of skill in the art would modify the prior art to remove a portion of the second film containing registration marks before attaching the second film to the substrate. For example, the reasoning provided based on Krawczyk discusses removing the entire top sheet, not a portion thereof.

Other assertions presented in support of the rejection of claims 8 & 25 are unsupported by any of the cited references (the asserted admitted prior art, Krawczyk and Jensen). For example, the Office Action presents the assertion that "removing the film before it is applied to the substrate is a matter of choice and within the purview of one of ordinary skill in the art. The choices are before or after and the artisan would know when it is preferable to remove any excess." That assertion is, however, not supported by any of the references that form the basis for this rejection. Furthermore, no reasoning is provided as to why one of skill in the art would be motivated to remove a registration mark used to align a film before the film is applied to the substrate (thereby complicating the registration process).

With respect to claims 9-12 and 27-29, Applicants submit that the Office Action also does not present a proper *prima facie* case of obviousness. For example, the Office Action does not identify which portions of the cited documents were relied upon for teaching or suggesting invisible registration marks. The Examiner asserted in, e.g., Paragraph 16, that Jensen "discloses a mark (19) on one film, which would be invisible to the naked eye", but fails to identify where

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Jensen teaches that the mark is invisible to the naked eye. Furthermore, the Office Action relies on the discussion presented in Paragraph 10 of the Office Action to support the rejection of claims 27-29, but Applicants note that the section of Krawczyk cited in Paragraph 10 (i.e., Col. 16, lines 43-47) teaches removing marks from the tiles, not the film as recited in the claims.

The Examiner also asserts in Paragraph 16 that "[t]he web position indicia are normally invisible, or nearly invisible, registration marks which are printed on each label." Applicants are unable to understand the nature of this assertion and request clarification so that it may be properly addressed by Applicants.

With respect to claim 14, Applicants submit that the Office Action does not present a proper *prima facie* case of obviousness. The Office Action asserts that registration marks distributed in regular intervals are found in the asserted admitted prior art, but no particular teaching is cited in support thereof. Likewise, it is asserted that Krawczyk teaches registration marks distributed in regular intervals. In fact, however, the parallel matching vertical guide lines (126 and 128, 132 and 134, 136 and 138) in cited Figures 17 & 18 of Krawczyk are spaced at irregular intervals (note how lines 134 and 128 are space closer to 138 than lines 136, 132 and 126 in Figure 17 of Krawczyk).

With respect to claim 18, Applicants note that the claim recites a method for providing registration between two films across the width of the films, i.e., in a direction transverse to the length along which the second film is being dispensed. That process is based on detecting the leading and trailing edges of the second registration marks. See, e.g., Specification, Page 7, lines 7-27 and Figure 1A. No such teachings are discussed in Jensen. Furthermore, the assertions presented in Paragraph 14 of the Office Action to support the rejection of claim 18 have no bearing on the actual invention recited in the claim. As a result, a *prima facie* case of obviousness has not been established with respect to claim 18.

With respect to claim 19, the asserted admitted prior art does not teach application of a first film under to a substrate under tension as asserted in the Office Action. Rather, panels

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applied after the first panel may be discontinuously stretched or pulled in various directions during installation to align them with a previously applied panel.

With respect to claims 21 and 22, Applicants note that the asserted admitted prior art teaches away from the use of longer films because of the increasing difficulty in handling longer films in a manual application process. This is in direct contradiction to the assertions presented on page 4 of the Office Action, which are, therefore, unsupported by the cited references.

For the above reasons, Applicants respectfully submit that claims 1-33 are patentable over the cited references (the asserted admitted prior art, Krawczyk, and Jensen). Reconsideration and withdrawal of the rejection of these claims are, therefore, respectfully requested.

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**Summary**

It is respectfully submitted that pending claims 1-33 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
Conrad V. ANDERSON et al.

By

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27 NOVEMBER 2002

Date

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**FAX RECEIVED****CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: Box AF, Washington, D.C. 20231, on this 27<sup>th</sup> day of November, 2002, at 10:58 A.M. (Central Time).

By: Name: Kevin W. Raasch